



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Bell, Boyd & Lloyd LLP  
3580 Carmel Mountain Road  
Suite 200  
San Diego CA 92130

**COPY MAILED**

JAN 21 2009

Applicant: Zhi et al.  
Appl. No.: 10/589,920  
International Filing Date: February 24, 2005  
Title: GLUCOCORTICOID RECEPTOR MODULATOR COMPOUNDS AND METHODS  
Attorney Docket No.: 119378-00314 / 1110US  
Pub. No.: US 2007/0281959 A1  
Pub. Date: December 6, 2007

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on February 5, 2008, for the above-identified application

The request is **granted-in-part**

Applicant requests that the application be republished because the patent application publication contains material errors on the front page of the publication wherein several inventors were omitted and in claims 1, 6, 46, 107 and 108 wherein there are typographical errors.

37 CFR 1.221 (b) is applicable “only when the Office makes a **material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable.” A material mistake must affect the public’s ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.<sup>1</sup>

The request by the Applicants to correct errors in the originally including the first preliminary amendment filed which includes the missing inventors and the errors in claims 1, 6 and 46 is **GRANTED**.

<sup>1</sup>Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

The errors noted by requestor with respect to the second preliminary amendment to the claims which relates to claims 107 and 108 are not Office errors, and therefore this portions of the request is **DISMISSED**.

The patent application publication does not include a mistake regarding the failure to include the second preliminary amendment to the claims in the publication by the Office because patent application publications are not required to include preliminary amendments, according to 37 CFR 1.215(a),<sup>2</sup> which says the following, in part:

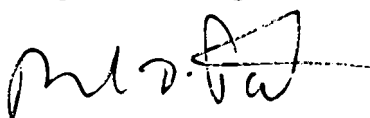
(a) . . . The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. **The patent application publication may also be based upon amendments** to the specification (other than the abstract or the claims) that are reflected in a substitute specification under Sec. 1.125(b), amendments to the abstract under Sec. 1.121(b), amendments to the claims that are reflected in a complete claim listing under Sec. 1.121(c), and amendments to the drawings under Sec. 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. (emphasis added)

§ 1.215(c) says the following:

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

Applicant did not file a copy of the application in compliance with the Office electronic filing system requirements.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709.



Mark Polutta  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy

---

<sup>2</sup>Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule, 69 FR 56482 (Sept. 21, 2004).